REMARKS

Claim Rejections

Claims 1-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over von Freyhold et al. (U.S. 6,594,092). Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over von Freyhold et al. as applied to claim 1 and further in view of Yui (U.S. 2002/0167689 A1). Claims 8-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yui in view of von Freyhold et al.

Abstract of the Disclosure

Applicant is submitting herewith a substitute Abstract of the Disclosure for that originally filed with this application to more clearly describe the claimed invention. Entry of the substitute Abstract oft the Disclosure is respectfully requested.

Drawings

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, Applicant must assume that the drawings are acceptable as filed.

Amendments to Specification

Applicant has amended the specification as noted above to cure obvious grammatical and idiomatic inaccuracies and to provide proper antecedent basis for reference numbers 51 and 52. No "new matter" has been added to the original disclosure by the foregoing amendments to the specification.

Claims

By this Amendment, Applicant has amended claims 1-6, and 8-14 of this application. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The primary reference to von Freyhold et al. discloses an optical module having a first optical bench (2) having a wall (7) closing an end thereof, an assembly holder (3), an element holder (4), a plurality of lenses (12, 15), and a fiber sleeve (17). The element holder (4) has two openings formed on opposite ends thereof, but the size of each opening is larger than that of the lenses, so that the fiber sleeve (17) can be positioned in the opening. Therefore, the quantity of the incident light corresponds to the configuration of the fiber sleeve (17) but not the size of the opening. Furthermore, the objective of von Freyhold et al. is to make available an optical or optoelectronic module, which can be assembled and adjusted simply and which ensures a precise beam pattern. von Freyhold et al. do not teach the reduction of the unwanted intermixing data due to the contour of the incident surface of the light. Unlike the present invention, the flap type light condensing device according to von Freyhold et al. has excessive light for interference of the light and intermixture of the data.

On page 2 of the outstanding Office Action, the Examiner admits that von Freyhold et al. do not "disclose that the lens are rectangular". On page 3 of the outstanding Office Action, the Examiner admits that von Freyhold et al. do not "disclose the frame integrally formed of plastic, metal, or ceramic material." On page 3 of the outstanding Office Action, the Examiner admits that von Freyhold et al. do not "disclose the lense formed of plastic material and the frame made of metal or ceramic material. On page 4 of the outstanding Office Action, the Examiner admits that von Freyhold et al. do not teach "a light incidence piece, a light condensing piece set and a light splitting piece, said light incidence piece has a size corresponding to the scan size of a scanner, said light [splitting] piece has a size corresponding to that of a charge coupled device, and said light condensing lens set is composed of more than one lens." On page 6 of the outstanding Office Action, the Examiner admits that von Freyhold et al. do not "disclose the hollow frame having rectangular openings at two ends.

von Freyhold et al. do not teach each of the rectangular openings being a contour restricted by a contour of each of the plurality of lenses.

Yui discloses an image reading unit having a light source device (6), reflecting mirrors (20-24), and a condenser lens (27).

Yui does not teach a hollow frame with rectangular openings, nor does Yui teach each of the rectangular openings being a contour restricted by a contour of each of the plurality of lenses, which has a contour restricted by those of the lenses, in order to control the quantity of the incident light to avoid the intermixture of the data.

Even if the teachings of von Freyhold et al. and Yui were combined, as suggested by the Examiner, the resultant combination does not suggest: the hollow frame having rectangular openings at two ends; nor does the combination suggest each of the rectangular openings being a contour restricted by a contour of each of the plurality of lenses.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

> The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

> As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

> We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either von Freyhold et al. or Yui that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither von Freyhold et al. nor Yui disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: October 27, 2004 By: 

Bruce H. Troxell
Reg. No. 26,592

TROXELL LAW OFFICE PLLC
5205 Leesburg Pike, Suite 1404
Falls Church, Virginia 22041
Telephone: 703 575-2711
Telefax: 703 575-2707